

## **REMARKS**

This is a submission pursuant to 37 C.F.R. 1.114 to the Office Action mailed July 20, 2005. The Examiner's review and reconsideration of this application in light of the foregoing amendments and the following remarks is courteously requested.

By the forgoing amendment, claims 31 through 34 have been amended. Claims 42 through 49 have been cancelled. Claims 50 through 69 have not been amended hereby. Claims 70 through 77 have been added. Consequently, claims 31 to 41 and 50 through 77 remain pending for the Examiner's consideration.

In the Office Action, claims 31-34, 37, 42-44, 46, and 50-68 were rejected as being anticipated under 35 U.S.C. § 102(e) by Furst (USP 6,297,819, hereafter referred to as Furst herein); and claims 35, 36, 38-41, and 45-49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Furst. Applicants respectfully traverse in part and have amended to overcome in part the rejections of these claims, as more specifically detailed below.

### **Rejections under 35 U.S.C. 102(e)**

With regard first to the rejection of claim 31, that claim has been amended in part to recite that "the frame and first Internet content [are] rendered independently from a Web browser program". (Claim 31, as amended herein, lines 7-8.) That is, no web browser program need be running or even accessed in order to render the frame and content according to the present invention. This is in stark contrast to the disclosure of Furst, which expressly states that the each tool is displayed as a web browser window.

For example, the very section cited against claim 31 in the Office Action states that “[t]he client browser (that is, the web browser embedded in the client) generally maintains at least one client browser window for each active (that is, open) tool.” (Furst, col. 7, lines 62-65). Furthermore, applicant finds no statements or suggestions in Furst which might be interpreted as a disclosure of rendering a “tool” independent of a web browser program. Indeed, there are many other references to Furst’s dependence on a web browser, such as “[T]he discussion tool user interface is defined by a discussion tool home page, which is displayed in a client discussion tool window by the client’s embedded browser...the discussion tool user interface is defined by a web page.” (Furst, col. 9, lines, 12-16, emphasis added.) See also the windows (or frames) illustrated in Figs. 4A and 5 from Furst, in which one consistently finds the icon for Internet Explorer in the upper right corner, implying the dependence on an underlying browser program.

It is well established that “[a] claim is anticipated [under 35 U.S.C. § 102(e)] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Furst clearly fails to expressly or inherently teach the element of rendering independent of a web browser program. Thus, claim 31 and all claims which depend therefrom, are clearly patentably distinct from over Furst. Thus, applicant respectfully requests reconsideration of claim 31, as well as claims 32 through 41 which depend from claim

31 (without expressly discussing further distinctions based on specific elements found in claims 32 through 41 which are not also found in Furst).

Claims 42-44, 46 have been cancelled herein, and thus are not further discussed.

With regard to claims 50-68, applicant has amended the independent claims in this group, namely claims 50 and 62, to contain the limitation that the “user interface” (and with regard to claim 50, the content data as well) is rendered independently from a Web browser program. (See claim 50, line 7, and claim 62, lines 8-9, each as amended herein.) Again, Furst is critically dependent on a web browser program to enable the display and use of the “tools” taught therein. Furthermore, Furst lacks an express or inherent teaching of rendering and using tools independent of a web browser program. Accordingly, claims 50 and 62, as well as those claims depending directly or indirectly therefrom, are patentably distinct from the Furst reference (again, without further discussion of those specific elements found in the claims depending from claims 50 and 62 not also found in Furst).

#### Rejections under 35 U.S.C. 103(a)

The Office Action rejected claims 35, 36, 38-41, and 45-49 (now cancelled) under 35 U.S.C. 103(a) as being unpatentable over Furst. Specifically, it was asserted that Furst substantially discloses the invention claimed in claims 35, 36, and 45, apart from the internet content being XML code. However, it was also asserted that internet

content being XML code, and XML tags used to define a frame are well known. No citation was provided for this assertion.

Initially, applicant responds that claim 31, from which claims 35 and 36 depend, has been amended in part to recite that "the frame and first Internet content [are] rendered independently from a Web browser program". (Claim 31, as amended herein, lines 7-8.) As discussed above, this limitation is neither present nor suggested by the disclosure of Furst. In stark contrast, Furst is expressly clear about its dependence on a web browser. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Thus, Furst cannot and does not render claims 35 and 36 obvious under 35 U.S.C. 103(a).

However, it should also be noted that there is no support for the assertion that, at the time of applicant's invention, it would have been obvious to combine the teachings of Furst with Maslov (USP 6,538,673), and Morrison, Michael (XML Unleashed), which are apparently also applied to claims 35 and 36 at paras. 17 and 18 of the Office Action, although not directly as part of the rejection of these claims). In establishing a prima facie case of obviousness relying on the combination of two references, the references must disclose a reason or motivation to combine their teachings to make the claimed invention. In re Dillon, 919 F. 2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(en banc), cert denied, 500 U.S. 904 (1991). Furthermore, it is not enough that there is some abstract motivation for combining references. Rather, a person of

ordinary skill in the art must be provided some motivation by the references to combine their teachings in the particular manner claimed. In re Koltzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). "In other words, the examiner [has the burden to] show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998)(emphasis added).

The Examiner has not met this burden with the conclusory statement that "it would have been obvious to one of ordinary skill in the art to include XML tags to (sic) the system of Furst to provide a more robust method of coding icons and window bars associated with the invention, thereby allowing another method to provide third parties to code applications easily." (Office Action, para. 13.) Nor the statement that the Morrison reference "describes that JavaScript supports XML and this would lead one of ordinary skill in the art for (sic) using XML codes and tags to define a frame." (Office Action, para. 18, which incidentally refers to calculating the area of a rectangle not, as asserted, the definition of a frame.) Each such statement, in the words of the Board of Patent Appeals, "is a conclusion, rather than a reason." Ex parte Garrett, 1986 Pat. App. LEXIS 8, 4 (EPAI 1986) . For at least this additional reason, the rejection of claims 35 and 36 is legally insufficient and should be reconsidered and withdrawn.

Claim 38 has been rejected in view of Furst, and further in view of the assertion that "it is well known that JavaScript has the capability of defining a frame for the tool and one of ordinary skill in the art would find it obvious to do so." Once again, applicant

highlights that claim 31, from which claim 38 indirectly depends, has been amended to recite that rendering a frame and content are independent of a browser program. Furst effectively teaches just the opposite – a stated dependence on a browser program. No other reference has been cited which suggests rendering a frame and content independent from a browser program nor modifying Furst to do so. Thus, at least by way of its dependence on claim 31, claim 38 cannot be and is not obvious in light of the cited references.

And yet again, applicant asserts that there is no support for the assertion that, at the time of applicant's invention, "it would have been obvious to one of ordinary skill in the art to include JavaScript tags in the code in order to provide a more robust method of coding the icons and windows and a bar in order to provide a language in which many browsers understand (sic), thereby increasing the accessibility of the invention." (Office Action, para. 14.) Such an unsupported conclusion does not form the foundation of an effective prima facie case of obviousness. Id. Accordingly, applicant offers this further ground for reconsideration and allowance of claim 38.

Finally, claims 39-41 and 47-49 have been rejected in view of Furst and the assertion that "these functions [calculator, media player, and means for accessing streaming media, respectively] are well known to exist." Claims 39-41 depend either directly or indirectly from claim 31. (Claims 47-49 have been cancelled.) As has been discussed several times above, claim 31 has been amended to recite that rendering a frame and content are independent of a browser program. Furst's disclosure is dependent on a browser program. No other reference has been cited which suggests

rendering a frame and content separate from a browser program nor modifying Furst to do so. Thus, at least by way of its dependence on claim 31, claims 39-41 cannot be and are not obvious in light of the cited references.

While unclear from the nontraditional form paragraphs 20 and 21 of the Office Action, there are apparently further grounds for rejecting claims 39-41. With regard to claim 39, the Office Action apparently combines Furst with Strandberg et al. (USP 6,816,880). With regard to claims 40 and 41, the Office Action apparently combines Furst with Nishizawa (USP 6,842,779). Applicant asserts that neither of these combinations teaches or suggests that the disclosure of Furst be modified to provide a frame and content independent of a web browser (as distinguished from a frame being rendered outside of a browser window). Thus, to the extent that paragraphs 20 and 21 are further rejections of claims 39-41, the amendments made herein address and overcome those rejections.

### **Conclusion**

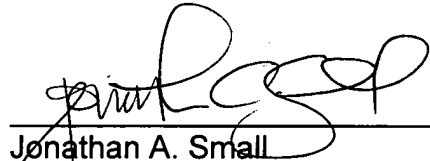
For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration and issuance of a formal Notice of Allowance for this application in light of the amendments and remarks provided above is respectfully requested.

By action taken here, Applicant in no way intends to or causes any surrender of any subject matter or range of equivalents beyond that strictly required to patentably

distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves without dedication all such subject matter and equivalents that may fall in the range between Applicant's literal claim recitations and combinations taught or suggested by the prior art.

If the Examiner believes that a telephone conference would expedite prosecution and allowance of this application, please telephone the undersigned at 650-941-4470.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jonathan A. Small", is written over a horizontal line.

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